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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

JOHNSON, JERROLD D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/781,962

Applicant(s)

WILSON ET AL.

Examiner

Jerrold Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 11-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/26/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-10, drawn to a package, classified in class 206, subclass 459.5.
- II. Claims 11-21, drawn to method of manufacture, classified in class 53, subclass n/a.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make other and materially different product such as an adhesively backed label.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Kit Stetina on 17 February 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-21 are withdrawn from further

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consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Knoerzer et al. US 6,746,743.

Knoerzer discloses a package, comprising:

an inner layer 80 having an inner layer inner surface and an inner layer outer surface,

a liner layer (the release agent disposed on surface 110) having a liner layer inner surface and a liner layer outer surface,

the liner layer inner surface adhered to the inner layer outer surface (this adherence is inherently disclosed in the reference);

an outer layer (50) having an outer layer inner surface and an outer layer outer surface, the outer layer inner surface adhered to the liner layer outer

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surface (through adhesive 100), the outer layer outer surface having at least one decorative area (disclosed as a gaming piece or coupon); and

at least one removable decal being formed by cutting a perimeter around the at least one decorative area into the outer layer, the at least one removable decal having a non-sticky top surface and a sticky bottom surface, the sticky bottom surface being adhered to the liner layer outer surface such that the at least one removable decal can be removed from the liner layer and affixed to an external object.

With respect to claim 6, the outer layer is made from a vinyl material.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2-5, and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knoerzer et al. US 6,746,743 in view of Official Notice.

With respect to claims 2 and 3, the inclusion of a protective covering removably surrounding the outer layer outer surface, and wherein the protective covering is a shrink wrap covering is well known with respect to containers such as food bags and boxes that are packaged in groups of 2 or more, so as to secure the food bags or boxes together as a single unit.

Accordingly, it would be obvious to one of ordinary skill in the art at the time of the invention to manufacture the package of Knoerzer with a shrink wrap covering.

With respect to claim 4, Knoerzer is silent with respect to the number of sheets of material used to manufacture the inner layer of the package, but it is well known to manufacture bags from a single sheet of material so as to simplify the manufacturing process.

Accordingly, it would be obvious to one of ordinary skill in the art at the time of the invention to manufacture the bags of Knoerzer with a single material.

With respect to claim 5, paperboard products including cardboard are materials that are able to be manufactured with coatings rendering the material suitable for food storage. For example, bags in which bulk coffee is purchased are typically of a stiff paperboard material, as the stiff paperboard material is strong and tear resistant. Other food products are also available in stiff paperboard bags so as to properly protect the product. Additionally, there is no disclosure in Knoerzer or the prior that would indicate that his package could not be manufactured with a cardboard inner layer in place of the inner film layer

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disclosed. And, the expression "cardboard" is not defined in the specification with respect to a specific structure or material thickness.

Accordingly, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the bag of Knoerzer with a cardboard material inner layer as a cardboard inner layer so as to provide a higher degree of protection to the product during shipment.

With respect to claim 7, it is well known to manufacture product labels and stickers/decals with all types of surface conditions including glossy finishes.

Accordingly, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the package of Knoerzer with the provision of a glossy outer surface, so as to increase the merchandising visibility of the product.

With respect to claims 8 and 9, Knoerzer discloses a release agent layer but does not disclose the content of that release agent. Silicone plastic-based release agents are now standard, but paper-based release agents are also known in the prior art. See for example Weidman US 3,953,564 (column 4, lines 7-12).

Accordingly, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the package of Knoerzer with release agent such as silicone or a paper-based release agent such as the cellulose fiber/methyl chloride release agent disclosed by Weidman, as both types of release agents are known in the art and would each have their respective benefits depending on the other layers used in the laminate.

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Claim 10 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Knoerzer.

Claim 10 includes the product-by-process limitation "wherein the at least one removable decal is formed using kiss-cutting." Product-by-process claims are not limited to the manipulations of the recited steps, only to the product implied by the steps.

Kiss-cutting is believed to refer to a specific die cutting process, and that process is necessarily shown in the reference to Knoerzer. Since the claimed product appears to be the same or similar to that of Knoerzer which is produced by die cutting, the claim is appropriately rejected under 35 U.S.C. 102(e) as being anticipated by Knoerzer.

Alternatively, in the event there are structural differences resulting from the kiss cutting method, it would have been obvious to have employed other prior art known methods like kiss cutting to cut out the removable decal so as to provide the benefits afforded by those processes, for example cost savings.

Claims 1 is rejected under 35 U.S.C. 102(b) as being unpatentable over Aoyagi US 3,925,585 Aoyagi discloses a package, comprising:

an inner layer 16, 16' having an inner layer inner surface and an inner layer outer surface, a liner layer 13 having a liner layer inner surface and a liner layer outer surface,

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the liner layer inner surface adhered to the inner layer outer surface (this adherence is performed through adhesive 12, See Fig. 4B, note that the claims to do not require an adhesive applied between the inner layer and the liner layer);

an outer layer (11) having an outer layer inner surface and an outer layer outer surface, the outer layer inner surface adhered to the liner layer outer surface (through adhesive 12), the outer layer outer surface having at least one decorative area (see Figs. 15A and 15B); and

at least one removable decal being formed by cutting a perimeter around the at least one decorative area into the outer layer, the at least one removable decal having a non-sticky top surface and a sticky bottom surface, the sticky bottom surface being adhered to the liner layer outer surface such that the at least one removable decal can be removed from the liner layer and affixed to an external object.

Claims 2-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyagi in view of Official Notice.

With respect to claims 2 and 3, the inclusion of a protective covering removably surrounding the outer layer outer surface, and wherein the protective covering is a shrink wrap covering is well known with respect to containers such as food bags and boxes that are packaged in groups of 2 or more, so as to secure the food bags or boxes together as a single unit.

Accordingly, it would be obvious to one of ordinary skill in the art at the time of the invention to manufacture the package of Aoyagi with a shrink wrap covering.

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With respect to claim 4, Aoyagi is silent with respect to the number of sheets of material used to manufacture the inner layer of the package, but it is well known to manufacture packaging from a single sheet of material so as to simplify the manufacturing process.

Accordingly, it would be obvious to one of ordinary skill in the art at the time of the invention to manufacture the bags of Aoyagi with a single material.

With respect to claim 5, Aoyagi discloses bag or box type packages. It is well known to construct boxes from cardboard.

Accordingly, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the box of Aoyagi with a cardboard material inner layer as a cardboard inner layer so as to provide a higher degree of protection to the product during shipment.

With respect to claims 6-9, many types of plastic and paper materials are utilized in liner layers and outer layers having removable decals. See for example UK 2226297, page 4, which describes both plastic and paper materials and the aforementioned Knoerzer, which describes vinyl.

Additionally, as was previously stated, glossy finishes are also well known for their benefits in the marketplace.

Accordingly, it would be obvious to one of ordinary skill in the art at the time of the invention to provide the package of Aoyagi with a liner layer of paper or plastic materials depending on the quality of the decal desired and to modify the package of Aoyagi with the provision of a glossy outer surface, so as to increase the merchandising visibility of the product.

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Claim 10 is rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Aoyogi.

Claim 10 includes the product-by-process limitation "wherein the at least one removable decal is formed using kiss-cutting." Product-by-process claims are not limited to the manipulations of the recited steps, only to the product implied by the steps. Kiss-cutting is believed to refer to a specific die cutting process, and that process is believed necessarily shown in the reference to Aoyogi. Since the claimed product appears to be the same or similar to that of Aoyogi which is produced by die cutting, the claim is appropriately rejected under 35 U.S.C. 102(a) as being anticipated by Aoyogi.

Alternatively, in the event there are structural differences resulting from the kiss cutting process, it would have been obvious to have employed other prior art known methods of die cutting like kiss cutting to cut out the removable decal so as to provide the benefits afforded by those processes, for example cost savings.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dunsirn et al. US 4,479,838 discloses directly adhering a liner layer to an inner layer.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerrold Johnson whose telephone number is 571-272-7141. The examiner can normally be reached on 9:30 to 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDJ


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